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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/649,477	08/26/2003	Michael Stilgenbauer	DKT02032	5383

7590 05/10/2005

BorgWarner Inc.  
Patent Administrator  
3850 Hamlin Road  
Auburn Hills, MI 48326-2872

EXAMINER
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TRIEU, THAI BA

ART UNIT	PAPER NUMBER
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3748

DATE MAILED: 05/10/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/649,477

Applicant(s)

STILGENBAUER, MICHAEL

Examiner

Thai-Ba Trieu

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 11 April 2005.  
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 11-31 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☒ Claim(s) 15-17, 20, 26, 29 and 30 is/are allowed.  
6) ☒ Claim(s) 11-14, 18, 19, 21-25, 27, 28 and 31 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.  
10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some \* c) ☐ None of:  
1. ☒ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_.  
5) ☐ Notice of Informal Patent Application (PTO-152)  
6) ☐ Other: \_\_\_\_\_.

### DETAILED ACTION

This Office action is in response to the Amendment filed on April 11, 2005. Applicant's cooperation in correcting the informalities in the abstract is appreciated. Claims 1-10 were cancelled; and claims 11-31 were amended.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

***Claims 11-14, 18-19, 21-25, 27-28 and 31 are rejected under 35 U.S.C. 102(e) as being anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Fukaya et al. (Patent Number 6,558,117 B1).***

**Regarding claim 11, Fukaya discloses a turbocharger comprising:**

a turbine housing (1), with

at least one supply channel means (Not Numbered) said housing (1) for supplying said exhaust gas (See Figure 1);

wherein at least one turbine rotor rotatably supported within said housing (1), said supply channel means being arranged to supply said exhaust gas to said turbine rotor (5) in order to rotate it (See Figure 1);

spacer means (3, 4) forming a passage of variable cross-section between said supply channel means (Not Numbered) and said turbine rotor (5) in order to

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control the amount of exhaust gas admitted to said turbine rotor (5) said means including:

a plurality vanes (2) predetermined width distributed in an annular vane space (Not Numbered) of approximately said width around said turbine rotor having two axial ends to form a passage between them for admitting exhaust gas to said turbine rotor (5) each vane (2) being pivoted about an axis to enable control of the amount of exhaust gas (See Figure 1),

a vane support ring member (6) supporting said axes of said vanes (2), said vane support ring member (6) defining one axial end said annular vane space by a first circumferential surface (See Figure 1),

a housing ring (Not Numbered) facing and being spaced from said support ring member (6) by said width to define the other axial end of said annular vane space by a second circumferential surface (See Figures 2-3), and

at least two spacer means (3, 4) integrally formed on at least one of said circumferential surfaces of ring members said housing ring (Not Numbered) or said support ring member (6) by embedding, casting, or machining, and being distributed over its respective circumferential surface to ensure said width of said vane space (See Figures 1-3, Column 3, lines 16-51).

The claimed phrase *“at least two spacer means integrally formed on at least one of said circumferential surfaces of ring members said housing ring or said support ring*

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*member by embedding, casting, or machining*" is being treated as a product by process limitation. As set forth in MPEP 2113, product by process claims are NOT limited to manipulations of the recited steps, only to the structure implied by the steps. Once a product appearing to be substantially the same or similar is found, a 35 USC 102/103 rejection may be made and the burden is shifted to applicant to show an obvious difference. See MPEP 2113 and *In re Marosi*, 218 USPQ 289 (Fed. Cir. 1983).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have said spacer means being integrally formed on at least one of said circumferential surfaces of ring members said housing ring (Not Numbered) or said support ring member, since it has been held that constructing a formerly integral structure in various elements involves only routine skill in the art. *Nerwin v. Erlichman*, 168 USPQ 177, 179.

**Regarding claims 12-14 and 27-28**, Fukaya discloses the invention as recited above, and further discloses at least one of said ring members (6) being of cast metal (See Column 8, lines 29-42) and said spacer means are formed in an outer circumferential border zone said circumferential surface of at least one of said ring members (See Figure 1); however, Fukaya fails to disclose said spacer means being integrally formed on said vane support ring member, said spacer means being integrally cast, and integrally formed in an outer circumferential border zone said circumferential surface of at least one of said ring members.

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It would have been obvious to one having ordinary skill in the art at the time the invention was made to have said spacer means being integrally formed on said vane support ring member, said spacer means being integrally cast, and integrally formed in an outer circumferential border zone said circumferential surface of at least one of said ring members, since it has been held that constructing a formerly integral structure in various elements involves only routine skill in the art. *Nerwin v. Erlichman*, 168 USPQ 177, 179.

**Regarding claims 18-19, 21-22, 24-25, and 31**, Fukaya further discloses said spacer means (3, 4) being elongated, vane-shaped (see Figures 1, 6, and 8); at least part of said spacer means (3, 4) having a bore (not Numbered) for passing a connection bolt (8) through (See Figure 1) and being connected to the opposite ring member (See Figure 2).

**Regarding claim 23**, Fukaya discloses a vane ring for a turbocharger comprising:

- an annular surface on both sides of a vane support ring member (6);
- a plurality of bores (wherein shafts 7 going through) distributed around the circumference of a passage in said annular surface for allowing passage of a plurality of vane (2) shafts (7);

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wherein spacer means (3, 4) integrally formed on said annular surface by embedding, casting or machining are distributed over the circumference of said annular surface (See Figure 1).

The claimed phrase “*spacer means integrally formed on said annular surface by embedding, casting, or machining*” is being treated as a product by process limitation. As set forth in MPEP 2113, product by process claims are NOT limited to manipulations of the recited steps, only to the structure implied by the steps. Once a product appearing to be substantially the same or similar is found, a 35 USC 102/103 rejection may be made and the burden is shifted to applicant to show an obvious difference. See MPEP 2113 and *In re Marosi*, 218 USPQ 289 (Fed. Cir. 1983).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have said spacer means being integrally formed on said annular surface, since it has been held that constructing a formerly integral structure in various elements involves only routine skill in the art. *Nerwin v. Erlichman*, 168 USPQ 177, 179.

#### ***Allowable Subject Matter***

Claims 15-17, 20, 26, and 29-30 are allowed.

#### ***Response to Arguments***

Applicant's arguments with respect to claims 11-31 have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thai-Ba Trieu whose telephone number is (571) 272-4867. The examiner can normally be reached on Monday - Thursday (6:30-5:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas E. Denion can be reached on (571) 272-4859. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for



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published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

TTB  
May 03, 2005



Thai-Ba Trieu  
Primary Examiner  
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